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09/843,150	04/27/2001	Pierre Chambon	065691/0219	7311

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EXAMINER

RIGGINS, PATRICK S

ART UNIT

PAPER NUMBER

1633

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/843,150

Applicant(s)

CHAMBON ET AL.

Examiner

Patrick S. Riggins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,6,8-13,17,18,20-24,26-33,35,37,39-46 and 49-53 is/are pending in the application.
- 4a) Of the above claim(s) 26-33,35,37,39-46 and 49-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8-13,17,18,20-24 and 53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Receipt is acknowledge of an amendment filed 5/6/05 in which claims 5, 15, 16, 19, 34, 36, 38, and 54 were cancelled and claims 1, 17, 18, 20, 21, 33, 35, 42, and 53 were amended. Presently claims 1, 6, 8-13, 17, 18, 20-24, 26-33, 35, 37, 39-46, and 49-53 are pending, with claims 26-33, 35, 37, 39-46, and 49-52 withdraw pursuant to the restriction requirement, and claims 1, 6, 8-13, 17, 18, 20-24, and 53 are under examination.
2. Any rejection of record in a previous Office Action not addressed herein is withdrawn.

### ***Drawings***

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because many of the drawing s are dark and difficult to read. Specifically, figures 6 and 11 fail to show anything that is discernable. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because use of the term "said" throughout constitutes legal phraseology. Further, the last sentence should be deleted, as the claimed subject is not in agreement with this sentence due to the restriction requirement. Correction is required.

See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities: on page 26, the title "Figures " should be replaced with --Brief Description of the Drawings--. Further, the description of the Figures should refer to each panel of the figure. For example "Figure 1" on page 26, line 3 should instead recite --Figures 1A-1D--.

Appropriate correction is required.

### ***Double Patenting***

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 3 of copending Application No. 10/475,962. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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9. This rejection is based upon the claims pending in 10/475,962 as of the 1/27/04 amendment to the claims. Reference claim 3 depends from reference claim 1 and thus recites all of the limitations of reference claim 1. Thus reference claim 3 is identical in scope to instant claim 1.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 6, 8-11, 13, 17, 18, 20-24, and 53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 8-11, 13, 17, 18, and 20-24 of copending Application No. 10475,962. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

12. As indicated above, reference claim 3 is identical in scope to instant claim 1. Each of the additionally cited reference claims comprises the identical limitations to those recited in the instant claim. The only difference is that the reference claims depend from reference claim 1 which is broader than instant claim 1 from which the instant claims depend. It would have been obvious to the skilled artisan to apply the particular limitations recited in the reference claims to

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reference claim 3 because reference claim 3 is a specifically recited embodiment encompassed by reference claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. It is noted that in the event of rejoinder of pending method claims with any allowed product claims of the instant application, new issues in regard to double patenting with the 10/475,962 application are likely to arise. It is noted that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner prior to issuance of the patent. See MPEP 804.01.

#### ***Response to Arguments***

13. Applicant's arguments filed 5/6/05 have been fully considered but they are not persuasive. Statutory double patenting can only be overcome through cancellation of or amendment to the claims. Further the obviousness-type double patenting rejection stands until an approved terminal disclaimer is filed.

#### ***Conclusion***

14. No claim is allowed.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick S. Riggins whose telephone number is (571) 272-6102. The examiner can normally be reached on M-F 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave T. Nguyen can be reached on (571) 272-0731. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick Riggins, Ph.D.  
Examiner  
Art Unit 1633



JAMES KETTER  
PRIMARY EXAMINER